

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No. 138065UL (MHM 15115US01))

In the Application of:
Mathew

Electronically Filed on November 20, 2007

Serial No.: 10/681,634

Filed: October 8, 2003

For: BIOMETRICALLY ENABLED
IMAGING SYSTEM

Art Unit: 3737

Examiner: Ramirez, John Fernando

Confirmation No. 6101

RESPONSE TO NOTIFICATION OF NON-COMPLAINT APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Paper responds to the Notification of Non-Compliant Appeal Brief mailed on November 14, 2007. The Examiner indicates that the “brief does not contain a correct copy of the appeal claims.” The Applicant respectfully disagrees.

The Examiner asserts that the Amendment Under 37 C.F.R. § 1.116 filed on March 20, 2007 should not be entered. In particular, the Advisory Action mailed on April 11, 2007 indicates that the amendments somehow “raise new issues,” and therefore should “not be entered.” See April 11, 2007 Advisory Action. However, **these claim amendments do not raise any new issue because they represent previously pending dependent claims that are incorporated into the text of the pending independent claims.** See March 20, 2007

Amendment at pages 9, and *compare, e.g.*, previously pending claims 2 and 3 at page 2 listed in November 14, 2006 Amendment with claim 1 at page 2 of March 20, 2007 Amendment. **In particular, claim 1 was amended to recite all the limitations of previously pending claims 2 and 3, while claim 10 was amended to recite all the limitations of previously pending claim 11, 12 and 15. The Applicants stress that claims 2, 3, 11, 12, and 15 were all previously examined.** *See, e.g.*, February 21, 2007 Office Action. Note, previously pending claim 3 depended from claim 2, which, in turn, depended from claim 1. *See* November 14, 2006 Amendment at page 2. Further, previously pending claim 15 depended from claim 12, which, in turn, depended from claim 11, which, in turn depended from claim 10. *See* November 14, 2006 Amendment at pages 4-5. Thus, the claim amendments **cannot, by definition**, raise any new issue. Indeed, the Examiner has provided absolutely no justification or reasons as to why an amendment of an independent claim to recite the **exact language** of a previously pending dependent claim, which was previously examined, should not be entered. Thus, the Applicant respectfully requests reconsideration of the Notification of Non-Compliant Appeal Brief.

If the Examiner persists in refusing to enter the amendments, the Applicant respectfully requests a citation to authority that prohibits the entering of an amendment that merely amends independent claims to recite the exact language of previously pending dependent claims that were already examined.

Respectfully submitted,

Date: November 20, 2007

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